

Application No.: 10/050477

Case No.: 57434US002

**REMARKS****Objections**

Claim 31 is objected to for allegedly being not clearly recited.

Applicant submits that the ordinary dictionary meaning of the word cart is intended. According to The American Heritage Dictionary of the English Language (Houghton Mifflin Company, 1996), "cart" is defined as "1. A small wheeled vehicle typically pushed by hand."

The Applicant has amended the claim to delete the redundant language of "having wheels" in claim 31.

**35 U.S.C. § 112 Rejections**

Claims and 19 and 30 have been rejected as failing to comply with the enablement requirement. Allegedly the language "a ribbon extrusion head" of claim 19 and "a harness" of claim 30 are not clearly described.

The Applicant submits that one of ordinary skill in the art understands what is meant by a ribbon extrusion head as described in the specification at p. 3, line 35 to p. 4, line 2 and p. 8, lines 7-14.

The Applicant submits that the ordinary definition of the term hardness is intended. According to The American Heritage Dictionary of the English Language (Houghton Mifflin Company, 1996), "harness" is defined as "1. The gear or tackle, other than a yoke, with which a draft animal pulls a vehicle or implement. 2. *Something resembling such gear or tackle such as the arrangement of straps used to hold a parachute.*"

Application No.: 10/050477Case No.: 57434US002**35 U.S.C. § 103 Rejections**

Claims 1-9, 11-14, 17-21 and 36-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Simmen (U.S. Patent No. 5,333,760).

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Simmen (U.S. Patent No. 5,333,760) in view of Summons (U.S. Patent No. 6,464,112).

Accordingly to the MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The Applicant submits that each of claims 1-22 recite "A **method** of applying a two-component **pavement marking composition**. . . ." Independent claims 1 and 21 recite the step of "dispensing the mixture with an applicator **onto pavement**", whereas independent claim 22 recites "dispensing the mixture onto pavement with a spray applicator". Claims 36-38 recite, "A **pavement surface having a marking prepared according to the method(s)** of claims 1, 21 and 23 respectively. The Applicant submits that the Examiner has failed to establish a prima facie case of obviousness with regard to claims 1-22 and 36-38 since none of the cited references teach or suggest pavement markings. Accordingly, the references fail to teach **all the claim limitations**.

With regard to claims 32-35, the Examiner acknowledges that Simmen fails to teach the specific volume of the first and second chambers. Accordingly, the references fail to teach **all the claim limitations**.

Application No.: 10/050477Case No.: 57434US002

The Examiner stated that, "It would have been an obvious matter of design choice to have the first and second chambers with the volume ranging from about 0.1 liters to about 10 liters. . ."

The Applicant submits that the references themselves provide no motivation to modify the volume of the chambers as presently claimed and thus the motivation to modify the reference to arrive at the claimed invention is based on hindsight.

The Applicant has responded to all the rejections set forth by the Examiners. Reconsideration and a timely allowance are respectfully requested.

Respectfully submitted,

3-23-04  
Date

By: Carolyn A. Fischer  
Carolyn A. Fischer, Reg. No.: 39,091  
Telephone No.: (651) 575-3915

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833